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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Edward O. Clapper	§	Group Art Unit:	2632
Serial No.:	09/904,236	§		
Filed:	July 12, 2001	§	Examiner:	Son M. Tang
For:	Processor-Based Positioning System	§	Atty. Dkt. No.:	ITL.0628US (P12052)

Box DAC
Assistant Commissioner for Patents
Washington DC 20231

**Petition to the Technology Center Director Pursuant to
MPEP § 1002.02(c)3(a) Premature Final Rejection**

Because the Examiner asserted a new ground of rejection in a second office action, the Examiner has prematurely finally rejected the Applicant's claims. A second or subsequent action should not be final where a new ground of rejection is asserted that was not necessitated by the Applicant's amendment of the claims. In response to the first action, Applicant amended its independent claims by merely incorporating the limitations of a respective dependent claim into the independent claim. Hence, the new ground of rejection was not necessitated by the Applicant's amendment.

Facts Involved

1. In the First Office Action, Paper No. 3, the Examiner rejected claims 1-4, 6-15, 17-24 and 26-30 under §102(e) as being anticipated by Jelen et al. Moreover, the Examiner rejected claims 5, 16 and 25 under 35 U.S.C. §103(a) as being obvious over Jelen et al. The Examiner cited Schkolnick, Heller and McDonald as pertinent prior art.

Date of Deposit: 7-10-02
I certify that this document and authorization to charge deposit account is being facsimile transmitted to the United States Patent and Trademark Office (Fax No. 703/308-7401) on the date indicated above.
Debra Cutrona
Debra Cutrona

2. On March 12, 2002, Applicant responded to the aforementioned rejections and amended independent claims 1, 11 and 21 to incorporate the limitations of a respective dependent claim.
3. On June 5, 2002, the Examiner mailed a Final Rejection, Paper No. 5, finally rejecting claims 1, 11, 21, 5-7, 17-19 and 24-26 under 35 U.S.C. §102(b) as being anticipated by Komatsu. Further, the Examiner rejected claims 2-4, 12-16, 22-23 and 27 under 35 U.S.C. §103(a) as obvious over Komatsu in view of Jelen.
4. The amended independent claims merely incorporated limitations set forth in a respective dependent claim, which did not necessitate the new ground of rejection asserted by the Examiner.

Points to be Reviewed

1. Amendment to Claim 1

Original claim 1 called for positioning a plurality of wireless tags around a facility, and providing a sensor associated with a user to sense the tags to determine the position of the user in the facility. Original claim 10 depended from claim 1 calling for obtaining information about the route and direction of travel of a user. Claims 1 and 10 were both rejected as being anticipated by Jelen.

Amended claim 1 calls for positioning a plurality of wireless tags around a facility, providing a sensor associated with a user to sense the tags to determine the position of the user in the facility, and obtaining information about the route and direction of travel of a user through the facility. Claim 10 was canceled without prejudice. Amended claim 1 is now rejected as being anticipated by Komatsu.

By examining original claims 1 and 10 and amended claim 1 it is readily apparent that the limitations set forth in claim 10 were

merely incorporated into independent claim 1. Thus, the new ground of rejection of claim 1 was not necessitated by the amendment.

2. Amendment to Claim 11

Original claim 11 called for receiving information from a plurality of wireless tags distributed about a facility, and analyzing information from the tags to determine the location of a user. Original claim 20 depended from claim 11 and called for obtaining information about the route and direction of travel of the user. Original claims 11 and 20 were both rejected as being anticipated by Jelen.

Amended claim 11 calls for receiving information from a plurality of wireless tags distributed about a facility, analyzing information from the tags to determine the location of a user, and obtaining information about the route and direction of the travel of the user through the facility. Claim 20 was cancelled without prejudice. Amended claim 11 is now rejected over Komatsu.

Clearly by reviewing original claims 11 and 20 and amended claim 11 one can see that the limitations set forth in original claim 20 were incorporated via amendment into claim 11. Thus, the new ground of rejection of claim 11 was not necessitated by the amendment.

3. Amendment to Claim 21

Original claim 21 called for a plurality of wireless tags, a wireless sensor associated with a user, a processor associatable with a user, and a storage coupled to the processor to determine the user's position based on information from the tags. Original claim 30 depended from claim 21 and called for tracking the

direction and movement of the user. Both original claims were considered by the Examiner to be anticipated by Jelen.

Amended claim 21 calls for plurality of wireless tags, a wireless sensor associated with a user, a processor associatable with a user, and a storage coupled to the processor to determine the user's position based on information from the tags, said processor tracks the direction and movement of said user. Original claim 30 was canceled. Amended claim 21 is now rejected over Komatsu.

By examining the original and amended claims it is clear that amended claim 21 merely incorporates the limitations set forth in original claim 30. Thus, the new ground of rejection of claim 21 was not necessitated by the amendment.

Requested Action

The Examiner's final rejection of the application was premature. Thus, it is respectfully requested that the final rejection be withdrawn.

Legal Argument

The Examiner prematurely finally rejected the Applicant's claims. Although it is true that a second action on the merits may be final, there are exceptions to this rule. For example, where the Examiner introduces a new ground of rejection that is not necessitated by the Applicant's amendment of the claims, the second rejection should not be final. See, M.P.E.P. §706.07(a), *Final Rejection, When Proper on Second Action*.

In the First Office Action, the Examiner rejected each of the Applicant's claims either under §102(e) or §103(a) citing the single reference, Jelen et al. In response to this rejection, the Applicant amended its independent claims to incorporate limitations set forth in a respective dependent claim. Each of the

independent claims and the respective dependent claims were rejected under 102(e) as being anticipated by Jelen. Thus, the Applicant pointed out how the amended claims were not anticipated by Jelen.

In the second Office Action, the Examiner rejected each of the amended independent claims under 35 U.S.C. §102(b) as being anticipated by Komatsu. Moreover, in the second Office Action, the Examiner rejected dependent claims 2-4, 12-16, 22-23 and 27 as being obvious over Komatsu in view of Jelen. In the first Office Action, Komatsu was neither relied upon to reject any of the claims nor was it made of record.

New limitations were not introduced by Applicant's amendments. Thus, the amendments did not necessitate the new ground of rejection. Moreover, claims 2-4, 12-16, 22-23 and 27, which were previously rejected under §102(e) as being anticipated by Jelen were not amended. However, in the second and final Office Action, the Examiner asserts a new §103(a) ground of rejection to reject these unamended claims. Thus, the applicant has not provided a basis for the Examiner to switch gears regarding the rejection of these claims. Accordingly, the finality of the rejection is premature.

It is the Examiner's duty to thoroughly search the disclosed invention and claims in the first action and apply the references fully therein. See M.P.E.P. § 706.07, *Final Rejection*. Moreover, switching from one set of references to another to reject claims that are substantially the same subject matter "defeat[s] attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection." *Id.*

The Examiner's failure to perform a thorough search in the first place is evidenced by the new ground of rejection for claims that contain the same subject matter. The effect of the Examiner's new ground of rejection in a final Office Action is to prematurely cutoff prosecution of the Applicant's application without reaching a clearly defined issue. Although the rules allow the second

rejection to be a final rejection, the Patent and Trademark Office does not "sanction hasty and ill-considered final rejections." *Id.*

As explained, the amendments proposed and entered did not change the subject matter of the claims. As a result, the Examiner's switching to a different reference and then finally rejecting the claims based on this new reference was hasty and ill-considered and does not allow a clear issue to be developed. Hence, the prosecution of this application has been prematurely cutoff. Because the prosecution has been prematurely terminated, the final rejection should be withdrawn so that a full and fair hearing may be achieved.

In sum, because prosecution has been prematurely terminated by the final rejection of the claims, the rejection should be withdrawn.

Fee

A petition brought forth pursuant to Rule 1.181 does not have a fee expressly provided for in Rule 1.17. The Commissioner is authorized to charge any additional fees to Deposit Account No. 20-1504 (ITL.0628US).

Statement that Petition is Timely Filed

The complained about action took place on June 5, 2002, thus, this matter has been addressed within 2 months of that date.

Respectfully submitted,



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